

REMARKS

Reconsideration and withdrawal of the rejections of the application are respectfully requested in view of the remarks and enclosures herein.

I. THE REJECTIONS UNDER 35 U.S.C. §112 ARE OVERCOME

Claims 14-15 were rejected under 35 U.S.C. §112, first paragraph, because the specification allegedly does not provide enablement for all compounds which inhibit the reductase activity of 11-Beta-hydroxysteroid dehydrogenase I in general. The rejection is respectfully traversed.

Initially, Applicants respectfully assert that the present claims do not relate to compounds which inhibit the reductase activity of 11-Beta-hydroxysteroid dehydrogenase I in general. Rather, the present invention relates to compounds which inhibit the reductase activity of 11-Beta-hydroxysteroid dehydrogenase I neural tissue.

The Examiner is respectfully requested to review the Declaration of Brian R. Walker and Jonathan R. Seckl, both of whom are inventors of the present application which was provided to the Patent Office on June 11, 2004.

As noted in that Declaration, the Figures of the present application provide doses of an inhibitor of the reductase activity of 11-Beta HSD1 from which the skilled artisan can make and use the claimed invention, without undue experimentation. Additionally, as to inhibitors of 11-Beta HSD1, the article by Monder and White (which accompanied the Declaration), in Table IV at pages 196-198 provides a rather lengthy list of inhibitors of 11 β -hydroxysteroid dehydrogenase, such that contrary to the Office Action, it is respectfully asserted that the skilled artisan understands compounds that "inhibit the reductase activity of 11-Beta-hydroxysteroid dehydrogenase I" and would readily understand how to use such compounds in the methods of the present invention without any undue experimentation.

Furthermore, in addition to those mentioned in the reference above, those documents which were cited in the prosecution of the parent application, U.S. Application Serial Number 09/029,535, now U.S. Patent 6,521,267, also show inhibitors and modes of administration, such as Walker et al., "Carbenoxolone Increases Hepatic Insulin Sensitivity in Man: A Novel Role for 11-oxosteroid Reductase in Enhancing Glucocorticoid Receptor Activation," J. Clin.

Endocrinology and Metabolism 80 (11): 3155-59 (1995). Thus, in the art, carbenoxolone and the lengthy list in Monder and White were known inhibitors.

The Examiner is also invited to review Appendix C to the previously filed Declaration which consists of two pages of a presentation originally provided to the Patent Office during the October 2, 2001 Interview during the prosecution of U.S. Application Serial Number 09/029,535, now U.S. Patent 6,521,267, and which was provided to the previous Examiner during the March 10, 2004 Interview.

Appendix C depicts results obtained with various known compounds, including chenodeoxycholic acid and frusemide in addition to carbenoxolone, that inhibit 11B-reductase in intact primary neurons and adipocytes. Therefore, Appendix C provides additional known inhibitors that so inhibit the enzyme in amounts disclosed in the application, such that based upon the knowledge in the art and the disclosure in the application, the invention can be practiced by one of skill in the art without undue experimentation.

Claims 14-15 were also rejected under 35 U.S.C. §112, second paragraph, as allegedly failing to particularly point out and distinctly claim the subject matter of the invention. The rejection is respectfully traversed.

Specifically, the Office Action alleged that one of skill in the art would be unable to determine compounds other than carbenoxolone encompassed by the claimed invention. Applicants respectfully disagree.

As described above, the previously submitted declaration, as well as the references provided in the parent application have provided numerous lists of compounds that “inhibit the reductase activity of 11-Beta-hydroxysteroid dehydrogenase I”. Accordingly, the skilled artisan would be familiar with these references and the compounds disclosed therein as inhibiting the reductase activity of 11-Beta-hydroxysteroid dehydrogenase I and would therefore readily understand the metes and bounds of the presently claimed invention.

Accordingly, the Examiner is respectfully requested to reconsider and withdraw the Section 112 rejections: The present application contains both a written description and enablement for the claimed methods, and, one skilled in the art, from the knowledge in the art and the teachings in the application, can fully understand the metes and bounds of the claims and can practice the claimed methods, without any undue experimentation, including without any

undue experimentation in selecting a suitable inhibitor, and a dose therefore and a route of administration thereof.

II. THE ART REJECTIONS ARE OVERCOME

Claims 14-17 were rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Stewart et al. Claims 14-17 were rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Walker et al. The rejections are respectfully traversed.

It is respectfully submitted that a two-prong inquiry must be satisfied in order for a Section 102 rejection to stand. First, the prior art reference must contain all of the elements of the claimed invention. *See Lewmar Marine Inc. v. Bariant Inc.*, 3 U.S.P.Q.2d 1766 (Fed. Cir. 1987). Second, the prior art must contain an enabling disclosure of the claimed invention. *See Chester v. Miller*, 15 U.S.P.Q.2d 1333, 1336 (Fed. Cir. 1990).

The present invention relates to methods for inhibiting reductase activity of 11-Beta-hydroxysteroid dehydrogenase 1 (11-Beta HSD1) in *an animal in need thereof* in neural tissue of the animal comprising administering to the animal an inhibitor of said reductase activity of 11-Beta HSD1 in an amount effective to so inhibit the reductase activity of 11-Beta HSD1, wherein the inhibitor is carbenoxolone or a pharmaceutically acceptable salt thereof.

Stewart et al. contains no teaching or suggestion of inhibiting 11-Beta HSD1 in an animal in need thereof in neural tissue, and especially no teaching or suggestion of inhibiting the reductase activity of 11-Beta HSD1 in *an animal in need thereof* in neural tissue.

Simply, Stewart et al. is silent as to the fact that 11-Beta HSD1 is a reductase in neural tissue, and that carbenoxolone may be administered to an animal in need thereof to inhibit the reductase activity of 11-Beta HSD1. Accordingly, the art rejection based on Stewart is improper and must be withdrawn.

Turning now to the rejections over Walker, Applicants respectfully disagree with the characterizations of the reference and would appreciate the opportunity to discuss the reference with the Examiner during a personal interview.

Therefore, reconsideration and withdrawal of the rejections under 35 U.S.C. § 102 are respectfully requested.

III. THE DOUBLE PATENTING REJECTIONS ARE OVERCOME

Claims 14-17 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claim 15 of copending U.S. Application Serial No. 10/061,044. The rejection is respectfully traversed.

As this is only a provisional rejection, Applicants respectfully request that the rejection be held in abeyance until such time as allowable subject matter is determined in one of the present application or in USSN 10/061,044.

REQUEST FOR INTERVIEW

If any issue remains as an impediment to allowance, we respectfully request a personal interview with the Examiner, his SPE, and a Group 1600 Practice Specialist, prior to issuance of any paper other than a Notice of Allowance; and, pursuant to this request the Examiner is also invited to contact the undersigned to arrange a mutually convenient time and manner for such an interview.

CONCLUSION

In view of the remarks and enclosures herewith, the application is now in condition for allowance. Consequently, reconsideration and withdrawal of the rejections, and prompt issuance of a notice of allowance, are respectfully requested.

Respectfully submitted,
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